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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 54

Application Number: 08/544,212

Filing Date: October 17, 1995

Appellant(s): RUSSO ET AL.

Robert J. Eichelburg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 30 December 2002.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with for the reasons set forth in the *Argument* below.

(8) ClaimsAppealed

A substantially correct copy of appealed claims 28, 29, 31-60, 65 and 66 appears on pages 22-26 of the Appendix to the appellant's brief. The minor errors are as follows: In claim

28, line 7 and claim 31, line 8 “200EC” should be –200⁰C--. In claim 34, lines 2 and 4, and claim 35, lines 2-4 “@” should be -- “ ” --, in each of the eight occurrences.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 28, 29, 31-60, 65 and 66 stand finally rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

(11) Response to Argument

The Rejection Under 35 U.S.C. §251

Claims 28, 29, 31-60, 65 and 66 stand finally rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Page 6, lines 8-9 of appellant’s brief admits that

at least claims 33-60, 65 and 66 are broadened. Reissue claim 28 differs from the broad patent claim in that the tin oxide component of claim 1 of the patent is expanded to the generic "metal oxide". Reissue claim 29 limits the metal oxide to a list of species intermediate that of reissue claim 28 and tin oxide. Reissue claim 31 differs from the broad patent claim in that the tin oxide component of claim 1 of the patent is expanded to the generic "metal oxide" and the scope of the accelerant additive is expanded from the group of borates, phosphites and water of the patent claims to include additional species. Reissue claim 32 limits the metal oxide to a list of species intermediate that of reissue claim 31 and tin oxide.

Prosecution History of the Patent

The limitation of the deposition rate in the original application was presented as making the invention allowable as an improvement not available in the prior art. ("The invention is made by CVD rates greater than about 350 angstroms/second"). Compositional limitations were added in response to the rejection of the claims as not enabled for the required deposition rates. In the patent the claims originally presented were rejected as not enabled under 35 U.S.C. §112(1) as the specification taught to obtain the required deposition rate of at least 350 Å/sec, the silicon oxide precursor of the base claim must be limited to that of claim 11. The examiner indicated that adding the limitations of claim 11 (wherein the silicon oxide precursor has the formula $R_mO_nSi_p$, where m is from 3 to 8, n is from 1 to 4, p is from 1 to 4 and R is independently chose from hydrogen and acyl, straight, cyclic, or branched chain alkyl or substituted alkyl or alkenyl or from one to about six carbons, and phenyl or substituted phenyl) to the base claim would make the remaining claims allowable. Applicant's added the limitations of claim 11 to the base claim and cancelled claim 11 as originally filed. In his reasons for allowance, the examiner

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stated: "The prior art of record fails to teach or suggest a gaseous composition comprising the recited tin oxide precursor, silicon oxide precursor and accelerant selected from borates, phosphites and water." No response to the Reasons for Allowance was filed even though it was explicitly invited in the next paragraph. The examiner required the amendment to include all the limitations of claim 11 in the base claim and intervening claims. Applicant's response filed that amendment.

Clement analysis

The instant claims can be divided into three groups: 1) Those not reciting the limitations of original claim 11 and expanding at least the requirement of the tin oxide precursor to instead include a precursor selected from a group including other metal oxide precursors, claims 33-57 and 60; 2) Claims 58 and 59 directed to films of the deposition product of compositions falling within the scope of patent claims and; 3) those requiring the limitations of claim 11 as originally filed in the patent application, but expanding at least the requirement of the tin oxide precursor to instead include a precursor selected from a group including other metal oxide precursors, claims 28, 29, 31, 32, 65 and 66.

The decision in *In re Clement*, 45 USPQ2d 1161, provides the principles for determining if improper recapture in a reissue case would occur.

(1) if the reissue claim is as broad as or broader than the canceled or amended claim [the surrendered subject matter] in all aspects, the recapture rule bars the claim; (2) if it narrower [than the surrendered subject matter] in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader [than the surrendered subject matter] in some aspects, but

narrower [than the surrendered subject matter] in other, then: (a) if the reissue claim is as broad or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

While much of the precedential opinion uses the phrase "in response to prior art rejection", (including parts of Clement, above) as it is the most common situation litigated, in its simplest terms the rule may be summarized (see *Ex Parte Daniel M. Eggert and Frank Mikic (deceased)*, Appeal No. 2001-0790, Decided: May 29, 2003; page 19, lines 1-4) as follows: "A patentee is precluded from recapturing in reissue that which he earlier conceded was unpatentable and abandoned or surrendered, whether by cancellation, amendment or argument of claims, for purposes of obtaining the original patent." See, *Ball Corp. v. United States*, 221 USPQ 289, 294. The decision not to appeal is an irrevocable admission of unpatentability. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 56 USPQ2d 1865. Each of the precedents establishing the recapture doctrine relies upon the same line of reasoning. Reissue does not give the patentee the right to prosecute *de novo* his original application. *In re Weiler*, 229 USPQ 673. The recapture rule prevents a patentee from regaining rejected subject matter. See also, *In re Wilder*, 229 USPQ 369, *In re Clement*, 45 USPQ2d 1161, *Mentor Corp. v. Coloplast, Inc.*, 27 USPQ2d 1521, *Haliczer v. United States*, 148 USPQ 565.

There is no specific point in the reasoning that would limit the recapture doctrine to surrender made only in response to prior art rejections. Consistency of reasoning requires that

the Supreme Court finding of *Festo* as to surrender be applied to reissue. *Festo* applies estoppel to response to any requirement of the Patent Act. *Festo*, itself, recognizes that the principles of prosecution history estoppel apply to reissue patents as does *Hester* at 1649. The alternative would engender the incongruous result that patent protection could be obtained under reissue, but not enforced in infringement proceedings.

MPEP 1412.03 provides instruction how one may determine reissued claims to varied statutory classes of invention are broadening as compared to the patent invention. Essentially, if the patent owner would be able to exclude an infringer whom the patent owner was unable to exclude previously, the claims are considered to have been broadened.

(1) Instant claims 33-57 and 60 do not recite the limitations of original claim 11 and expand at least the requirement of the tin oxide precursor to instead include a precursor selected from a group including other metal oxide precursors. Under part (1) of the analysis of *Clement*, these claims are as broad or broader than the cancelled subject matter in all aspects and they are barred by the recapture rule.

(2) Instant claims 58 and 59 are directed to film of the *deposition product* of a composition falling with the gaseous composition of the patent claims. As these claims are solely to a film that is a deposition product, there is no evidence of record that the precursors from which it is derived materially limit the claim. The evidence of record is only that the film comprises oxides of silicon, tin and phosphorous. The film is clearly broader than the gaseous composition. Just as a claim to the volatilization product of liquid water (water vapor) reads on any composition of water vapor whether that derived from liquid water, or synthesized directly as vapor, the instant film claims are limited only to a film of oxides of tin, silicon and

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phosphorous and therefore broader in the aspect germane to the rejection in that they do not require the specifics of the precursors of Patent claim 1, including those of original claim 11 added by amendment.

(3) Instant claims 28, 29, 31, 32, 65 and 66 are broader than the original base claim (rejected then amended in order to secure allowance) in that they do not limit the metal oxide precursor component to the tin oxide of the original. They are narrower than the amended base claim in that they recite the limitations of original claim 11 (wherein the silicon oxide precursor has the formula $R_mO_nSi_p$, where m is from 3 to 8, n is from 1 to 4, p is from 1 to 4 and R is independently chose from hydrogen and acyl, straight, cyclic, or branched chain alkyl or substituted alkyl or alkenyl or from one to about six carbons, and phenyl or substituted phenyl). The limitation of a tin oxide precursor is germane to the rejection made. The office action in which the rejection was made set forth that the limitations of claim 11 must be added to the base claim in order to overcome the rejection. Clearly, as the addition was to the base claim, the allowability of the claims was predicated on the limitations of that claim as well as those added from claim 11. Furthermore, the Reasons for Allowance issued in response to the amendment clearly set forth that "the recited tin oxide precursor, silicon oxide precursor and accelerant selected from borates, phosphites and water" were all required. Applicant manifested no disagreement with the reasons for allowance made of record. Additionally, *Hester Indus. Inc. v. Stein Inc.*, established that surrender could occur through arguments alone. Reissue does not give the patentee the right to prosecute *de novo* his original application. *In re Weiler*, 229 USPQ 673.

Intent to Claim

The prosecution history of the original application estopps applicant from asserting that the specification intended to claim or even included inventions not depositing at at least 350 Å/sec. The specification of the reissue patent sets forth the scope of the invention. Page 4, lines 50-51 and page 4, line 54 through page 5, line 3 recite: "The invention is made by CVD at rates greater than about 350Å/sec." And, "using a mixture which includes... metal oxide precursor... further includes silicon oxide precursor and one or more additives selected from the group consisting of phosphates, borates, water, alkyl phosphines, arsine and borate derivatives, PH₃, AsH₃ and B₂H₆ and O₂, N₂O, NF₃, NO₂ and CO₂." The rejection and statement of Reasons for Allowance established on the record that the original invention was limited to compositions including " the recited tin oxide precursor, silicon oxide precursor[R_mO_nSi_p, where m is from 3 to 8, n is from 1 to 4, p is from 1 to 4 and R is independently chose from hydrogen and acyl, straight, cyclic, or branched chain alkyl or substituted alkyl or alkenyl or from one to about six carbons, and phenyl of substituted phenyl] and accelerant selected from borates, phosphites and water." In the original application, claims limited to specific composition producing the required deposition rate are analogous to MPEP 1412.01(B). A specific intent not to claim subject matter not exhibiting the deposition rate is demonstrated. As exemplified in the MPEP,

The original patent specification would indicate an intent not to claim the subject matter of the claims presented in the reissue application in a situation analogous to the following: The original patent specification discloses that composition X is not suitable (or not satisfactory) for molding an item because composition X fails to provide quick drying. After the patent issues, it is found that composition X

would be desirable for the molding in spite of the failure to provide quick drying, because of some other newly recognized benefit from composition X. A claim to composition X, *or a method of use thereof* [emphasis added] would not be permitted in a reissue application, because the original patent specification contained an explicit statement of intent not to claim composition X or a method of use thereof."

In re Wesseler

That the originally rejected claims were amended in response to a rejection under 35 U.S.C. §112(1) rather than §103 does not prevent a finding of recapture. In *In re Wadlinger, Kerr and Rosinski*, 181 USPQ 826 the CCPA eviscerated its finding in *In re Wesseler*, 151 USPQ 339, relied upon by appellant, holding that the term "error" was broadened in §251. This finding of a broadened interpretation appears critical to the case. Further, the finding therein of no impermissible recapture appears to be predicated on the inability of the court to distinguish whether the amendments made to secure patentability were due to the rejection under §112(2) or the prior art such that the court could not determine which material had been actually surrendered.

Filing of additional claims in the original application.

It is unclear how applicant's submission of new additional claims of narrower scope, demonstrates that the limitations of the original base claim were not necessary for allowance. That the examiner has indicated reissue claims containing all the limitations recited in the Reasons for Allowance as allowable simply functions to further support the examiner's position.

The examiner required the amendment to include all the limitations of claim 11 in the base claim and intervening claims

The Claims Stand or Fall Together

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the brief fails to point out specific reasons why the claims are believed to be separately patentable with respect to the rejection under section 251. Appellants' argument appears to be a statement that each claim could be separately patentable at some future point. Appellant does not argue that claims 28-32 would be separately patentable with respect to the

The Offer to Dedicate Claims to the Public

There is no cited provision in Patent Law to resolve this controversy by dedication of the claims to the public at this point in the prosecution.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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Primary Examiner
Art Unit 1755



DMB
June 16, 2003

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